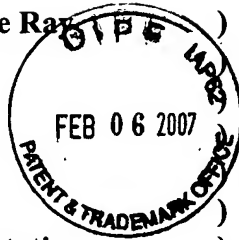


In re application of Claude Ray)

Serial No.: 10/824, 827)

Filed: 04/15/2004)

For: Jewelry Item with Rotating)
Gemstone)
)
)
)
)



Date: January 30, 2007

Group Art Unit: 3677

Examiner: Reese, David C.

Hon. Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, Virginia 22313

Mail Stop: Appeal Briefs-Patents

APPEAL BRIEF

I.

Real Party In Interest

The real party in interest is Joseph C. Koll, assignee.

II.

Related Appeals and Interferences

None.

III.

Status of Claims

Claims 1-5 and 7-10 have been canceled; claim 6 was previously withdrawn and is being canceled herein while claims 11-17, and 19-20 were finally rejected and are being appealed.

Claim 18 was deemed allowable

IV.

Status of Amendments

An amendment canceling claim 6 is being submitted herewith.

V.

Summary of the Claimed Invention

The present invention as claimed in independent claim 11 includes a jewelry item with a rotating gemstone comprising a substantially hollow housing 1 having an upper end 2 and a lower end 3, (p. 5, lines 17-19); a bezel 6 rotatably mounted on the upper end of said housing; a gemstone 8 mounted on said bezel; a motor means 14 received within said housing for automatically rotating said bezel and said gemstone at a predetermined, discrete speed; (p. 6, lines 2-7); a gear assembly including a plurality of gears driven by said motor means and operably connected to said bezel, (p.7, lines 11-12); said gears having a predetermined, precise gear ratio for rotating said bezel at a discrete speed, wherein said gear assembly further includes a drive gear 32 connected to said motor means, an intermediate gear 36 engaging said drive gear, (p. 7, lines 13-18); said intermediate gear having an upper surface with a sprocket 37 extending therefrom (p. 8, lines 1-2) and a bezel gear 43 connected to said bezel and engaging said sprocket.(p. 8, lines 11-12).

Claim 12, which depends from claim 11, defines said discrete speed as being between 2 and 4 revolutions per minute.(p.8, lines 18-19, p.9, lines 1-2). Claim 13, which depends from claim 11, defines the motor means as a quartz movement motor 14. (p. 6, lines 8-10).

Claim 14, which depends from claim 13, further defines the motor means as including an integrated circuit 61 for controlling speed and torque of said quartz movement motor. (p. 7, lines 6-7). Claim 15, which likewise depends from claim 13, defines the quartz movement motor as

including a casing 15 having an outer edge 18 with an indentation 19 thereon, said indentation substantially aligned with an opening on an outer wall 20 of said housing, said indentation having at least one electrical contact therein, said electrical contact electrically connected to said motor; (p. 6, lines 8-19).

Claim 16 depends from claim 15 and adds a switch 22 hingedly secured at a first end 23 to said housing, said switch carrying a battery 26 thereon, said switch having a free end 24 which is pivotal towards and away from said housing to selectively position said battery against said contact. (p. 6, lines 14-19; p. 7, lines 1-3).

Claim 17 depends from claim 11 further includes a lower spacer plate 33 superimposed on said drive gear, said spacer plate having an aperture 34 with said drive gear 32 received therein. (p. 7, lines 13-15). Claim 18 also depends from claim 11 and further adds a bezel attachment mechanism including a neck 56 projecting upwardly from said bezel gear, said neck having a peripheral lip 60; said bezel receiving said neck, said bezel including a circumferential slot 59 positioned beneath said lip; a clip 58 received within said slot to retain said bezel on said neck. (p. 9, lines 8-15).

Claim 19 depends from claim 17 and further narrows the lower spacer plate as having a depression 35 thereon that receives said intermediate gear. (p. 7, lines 17-18). Claim 20 depends from claim 19 which further adds an upper spacer plate 38 superimposed on said lower spacer plate with said intermediate gear positioned therebetween. (p. 8, lines 3-4).

VI.

Grounds of Rejection to be Reviewed on Appeal

Whether claim 11 is patentable under 35 U.S.C. 102(b) over U.S. pat. no. 1,025,447 issued to Blume; whether claims 11-12, 17, and 19-20 are patentable under 35 U.S.C. 103(a)

over U.S. patent no. 4,764,850 issued to Albanese in view of U.S. patent no. 5,971,829 issued to Hartman and whether claims 13-14 are patentable in light of Hartman, supra, Albanese, supra, in view of U.S. patent no. 6,209,242 issued to Marshall, and whether claims 15-16 are patentable when no reasons for rejection were provided or any references were cited in support of such rejection.

VII.

Argument

The examiner has again objected to the drawings on the basis that several features are not depicted in the “elected diagrams.” As such, he has rejected claims 15 and 16 according to 35 USC §112 asserting that the claimed features are not depicted in the drawings. However, such features are depicted in Figures 1 and 2 and such drawings were not canceled or deleted. 37 CFR 1.83 provides that:

(a) **The drawing** in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (*e.g.*, a labeled rectangular box). In addition, tables and sequence listings that are included in the specification are, except for applications filed under 35 U.S.C. 371, not permitted to be included in the drawings.” (Emphasis added).

The rule merely requires that “**the drawing**” must show the claimed features, not an “elected Drawing” or a drawing correlating to elected claims, or any other similar requirement. When an applicant elects a species, he or she elects claims directed toward the species,

not drawings. Accordingly, the examiner's continued insistence that the claimed figures must be shown in Figures 3-6 is erroneous. Regardless, for the foregoing reasons, the rejected claims depend from generic claim, which is allowable in light of the references of record herein.

Regarding the examiner's 112 rejection of claim 18, the claim correctly defines the subject matter. The device includes a neck 56 projecting upwardly from said bezel gear, said neck having a peripheral lip 60; said bezel receiving said neck, said bezel including a circumferential slot 59 positioned beneath said lip and a clip 58 received within said slot to retain said bezel on said neck. (P. 9, lines 8-15). There is no ambiguity in the claimed structure. The examiner states that "the ambiguity to the claim still resides in the statement failing to distinctly point out that the slot is found in the bezel, and that only when the bezel receives the neck in a particular configuration is the slot, of the bezel positioned beneath the lip of the neck." The slot is not found "in the bezel", but instead the bezel includes a circumferential slot. Furthermore, the latter half of the statement regarding "only when the bezel neck in a particular configuration is the slot, of the bezel, positioned beneath the neck" is not correct. The claim clearly states that the bezel is "receiving said neck;." the claim does not provide that the bezel is *for* receiving said neck. When the bezel receives the neck, the slot is positioned beneath the neck. The claim clearly indicates that the bezel is receiving the neck.

The examiner rejected claim 11 under 35 USC §102(b) in light of the patent to Blume. Please note that claim 11, formerly claim 7, was originally rejected in light of the patents to Albanese and Hartman. For the first time, the claimed elements are being rejected in a final action without affording applicant to present arguments or otherwise amend the claims to circumvent the device of Blume. In the detailed action, the examiner appears to have

renumbered the elements in Blume relative to what was originally cited in the patent document. For purposes of this brief, applicant will refer to the numerals contained within the patent. As best understood, the examiner asserts that Blume contains a drive gear (13) connected to said motor means and an intermediate gear (16) engaging said drive gear, said intermediate gear having an upper surface with as sprocket (18) extending therefrom...” The drive gear 13 is actually a pinion that engages a motor drive gear 12; the “intermediate” gear 16 does not engage either drive gear 12 or pinion 13. The patent provides that “**Another gear 15** also mounted on shaft 14, meshes with a pinion 16 on shaft 17.” (Emphasis added) See lines 79-80. Clearly, neither element 12 nor 13 engages “intermediate gear” 16. Gear 15 engages the “intermediate” gear while pinion 13 is positioned above the gear 15, and engages drive gear 12. The statement that the intermediate gear has an upper surface with a sprocket extending therefrom is likewise erroneous. The “sprocket” 18 is mounted on a shaft 17, and is positioned above the “intermediate gear” 16. However, it neither engages the intermediate gear 16 nor extends from the upper surface therefrom. The claimed interrelation of gears allows a precise gear ratio to be attained within an extremely small amount of space, which has not heretofore been contemplated. The gear mechanism of Blume requires far more gears than the present invention, and therefore does not disclose the exact claimed interrelation. The examiner has ignored the precise claimed interrelations of gears such as the sprocket extending from the upper surface of the intermediate gear and the intermediate gear engaging the drive gear. Furthermore, the patent to Blume neither discloses nor suggests any specific gear ratio or rotating the design element at a specific speed.

Claims 11-12, 17, and 19-20 were rejected in light of Albanese and Hartman. The

examiner rejected the claims under 35 U.S.C. §103 alleging, inter alia, Hartman teaches (the gear assembly as claimed). However, Hartman discloses a motorized ice cream cone, and in no way relates to jewelry. Furthermore, in spite of the examiner's assertions otherwise, the device of Hartman does not disclose the interrelation of gears as claimed.

To establish a prima facie case of obviousness, the examiner must establish, inter alia, that the references *teach or suggest* all claim limitations. M.P.E.P. § 2143.03. (Emphasis added). In applying 35 U.S.C. 103, the following factors should be considered:

1. The claimed invention must be considered as a whole;
2. The references must be considered as a whole and must suggest the *desirability* and thus the obviousness of making the combination;
3. The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention, and;
4. Reasonable expectation of success is the standard with which obviousness is determined. M.P.E.P. § 2141, citing *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 (Fed. Cir. 1986).

A statement that modifications of the prior art were well within the ordinary skill of the art because the references cited teach that all of the features are individually known does not establish a prima facie case of obviousness *without some objective reason to combine the teachings of the references*. (Emphasis added). M.P.E.P. § 2143.01, citing *Ex Parte Levengood*, 28 U.S.P.Q. 2d 1300 (B.P.A. I. 1993). The fact that the prior art could be modified in a manner suggested by the examiner did not make modification obvious unless prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260(Fed. Cir. 1992).

Applicants' gear system and drive motor assembly required many years of design to

achieve the proper torque and movement that could be produced on an item as minuscule as jewelry. The claimed gear assembly allows the gears and sprockets to be sized accordingly, while achieving the torque necessary to rotate stones weighing as much as 3.5 g. The relative weight being rotated by the quartz movement motor is much higher than that of conventional quartz movement applications, which is precisely the reason that jewelry having quartz movement motors for rotating a jewel stone do not exist in the prior art. The combination of sprockets, gears, and spacer plates with an aperture and an indentation for receiving a respective gear allow for a compact arrangement of gears that produce significant torque. Both the enhanced torque and compactness are mandatory in order to successfully achieve a quartz type movement on a jewelry item. The interrelation of gears and spacer plates are the result of specific design criteria after years of research and are not simply rearrangement of parts already existing in the prior art. Furthermore, the examiner has made no showing whatsoever how Hartman suggests adding its gear arrangement to a jewelry item to achieve the results of the present invention.

Not only is the claimed combination not disclosed or suggested in the prior art, the device in Hartman is a non-analogous art. For example, in *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992), the applicant claimed an improvement in a hose clamp which differed from the prior art in the presence of a preassembly "hook" which maintained the preassembly condition of the clamp and disengaged automatically when the clamp was tightened. The Board relied upon a reference, which disclosed a hook and eye fastener for use in garments, reasoning that all hooking problems are analogous. The court held the reference was not within the field of applicant's endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of

ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. MPEP §2141.01(a). Likewise, a jeweler looking to create jewelry having a quartz movement for slowly, smoothly and continuously rotating a gemstone, would not be expected or motivated to look to ice cream cone holders, particularly considering that implementing the gear assembly of Hartman would not function as does the claimed invention. The gear system of Hartman contains far more gears than that of the claimed invention and the specific interrelation of the gears as claimed is not disclosed.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The prior art is devoid of any suggestion or teaching of the gear assembly in combination with a quartz movement motor and/or the jewelry stone.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The examiner has not presented a convincing line of reasoning as to why the applicant could readily combine an ice cream cone holder with a spring motor operated jewelry display to form the claimed gear system.

Not only is the device of Hartman within a non-analogous art, the patent does not disclose the gear arrangement as the examiner contends. The examiner asserts that “Hartman further teaches of a drive gear (28a) connected to said means 24; an intermediate gear (28b) engaging said drive gear (28a), said intermediate gear (28b) having an upper surface with a sprocket (26) extending therefrom and a bezel gear (28c) connected to said bezel 32 via 30.” Element 28c is not a bezel gear nor is element 32 a bezel. As indicted, supra, the device in no way relates to jewelry, and therefore, the inclusion of a bezel or bezel gear would be neither expected nor suggested.

The Merriam-Webster online dictionary defines bezel as:

1 : a rim that holds a transparent covering (as on a watch, clock, or headlight) or that is rotatable and has special markings (as on a watch)

2 : the oblique side or face of a cut gem; *specifically* : the upper faceted portion of a brilliant projecting from the setting.

3 : a usually metal rim of a piece of jewelry in which an ornament (as a gem) is set.”

No such item is remotely disclosed in Hartman because the device in no way relates to jewelry or rotating parts therefor. Furthermore, element 24 is the motor drive shaft gear while element 22 is the motor. Claim 11 includes a drive gear connected to said motor means. Drive gear 28a is clearly not connected to motor 22. Though 28a is ultimately driven by the motor, it is not connected to it. The elimination of many of the gears found in conventional mechanical devices is one of the key aspects of the present invention in that it can be compactly contained while providing the torque necessary to drive a gemstone.

Claim 17 included the lower spacer plate superimposed on said drive gear, said spacer

plate having an aperture with said drive gear received therein. In rejecting the claim, the examiner states that “Hartman further teaches comprising a lower spacer plate (21b) superimposed on said driver gear (24), said spacer plate (21b) having an aperture (36b) with said drive gear received therein.” In rejecting claim 11, the examiner cited element 28a as the drive gear and element 24 as the motor means. Accordingly, the examiner uses one element to anticipate the drive gear for purposes of rejecting claim 11 while using another element as anticipating the drive gear in rejecting claim 17, which is clearly improper. Furthermore, gear 24 is not received within aperture 36b, but is instead superimposed thereon. In addition, element 21b is not superimposed on element 24; instead element 24 is superimposed on element 21b.

Claim 19 further defines the lower spacer plate as having a depression thereon that receives said intermediate gear. In rejecting the claim, the examiner states that “(i)t would have been an obvious matter of art recognized equivalence to create a depression or another hole for the intermediate gear to be positioned in/on, as the pertinence behind the intermediate gear is its position between both the drive gear and bezel gear as to properly provide the movement upwards; applicant has also not disclosed that it solves any stated problem of the prior art or is for any particular purpose. It appears that the invention would perform equally well as the invention disclosed by Albanese in view of Hartman.”

Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and

unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. See also *In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979). It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. See MPEP §2144.03.

The examiner has failed to show how the claimed depression is a recognized equivalent in the field of rotating jewelry. Accordingly, pursuant to MPEP §2144.03, applicant hereby demands that the examiner provide documentary evidence in support of his assertion of Official Notice.

Regardless of the Official Notice, the examiner's assertion is incorrect. The specification clearly explains that the claimed design allows the drive gear teeth to directly engage the intermediate gear teeth while the two components are lying in the same horizontal plane. The spacer plate design provides depth compactness while interrelating the gears, which is mandatory when incorporating the components within a small device such as jewelry, while providing structural integrity therefor. See the original specification, p. 7, lines 14-19; p. 8, lines 1-2. Claim 20 further adds that the upper spacer is superimposed onto the lower plate with the

intermediate gear positioned therebetween. The examiner states that Hartman includes “an upper spacer plate (21a) superimposed on said lower spacer plate (21b) with said intermediate gear (28b) positioned therebetween. Please note that elements 21a, 21b and 21c in Hartman are merely ribs within a housing for containing and supporting a circuit, the drive mechanism 26 and a cup 32. The structure in no way relates to spacer plates for tiered, interrelated gears.

Claims 13 and 14 directed toward the quartz movement motor were rejected under 35 U.S.C. 103(a) based on the patents above in view of Marshall. Though Marshall discloses a quartz movement motor, it does not suggest using a quartz motor for rotating a gemstone on a jewelry item. As stated above, the ability to do so before the invention of the claimed subject matter did not exist. Furthermore, the device is unrelated because it pertains to a rotating display, and not rotating a gemstone on a jewelry item. (See discussion, supra).

The examiner notes that Marshall teaches the use of an integrated circuit for controlling speed and torque of said quartz movement motor, referencing column 2, line 61. A review of the cited provisions reveals merely that “In a quartz oscillator, the extremely regular mechanical vibrations of a quartz crystal control corresponding electrical vibrations in a coupled electronic circuit...” The patent does not disclose or suggest the use of an integrated circuit with a quartz movement motor to control the speed and torque of the motor.

Finally, the examiner failed to address claims 15 and 16 in the detailed action other than the 112 rejections stated above; the examiner provided no other support for their rejection; claim 15 further defined the quartz movement motor as including

a casing having an outer edge with an indentation thereon, said indentation substantially aligned with an opening on an outer wall of said housing, said

indentation having at least one electrical contact therein, said electrical contact electrically connected to said motor.

Claim 16 includes:

a switch hingedly secured at a first end to said housing, said switch carrying a battery thereon, said switch having a free end which is pivotal towards and away from said housing to selectively position said battery against said contact.

None of the references cited herein disclose or suggest a quartz motor and switch means as claimed.

In conclusion, none of the references cited herein disclose a jewelry item containing the uniquely designed gear system for rotating a gemstone according to the claimed invention. In rejecting the claims, the examiner has applied references within a non-analogous art, and has improperly applied such references by ignoring claimed interrelation of parts where the claimed interrelation is not disclosed, even by the non-analogous references. Furthermore the examiner has repeatedly asserted that claimed combinations are obvious because each component within the claimed invention previously existed, without showing that combining the existing components is obvious. Furthermore, the examiner failed to address at least 2 claims (15 and 16), which contained substantial limitations regarding the quartz movement motor and its associated switch. Claims 15 and 16 should have been deemed allowable pending the correction of any 112 deficiencies, or they should have been rejected based upon cited references. Neither the above-mentioned references nor any other references were cited or asserted as disclosing or suggesting the features of claims 15 and 16.

VIII.

Claims Appendix

Claim 11. A jewelry item with a rotating gemstone comprising:

a substantially hollow housing having an upper end and a lower end;

a bezel rotatably mounted on the upper end of said housing;

a gemstone mounted on said bezel;

a motor means received within said housing for automatically rotating said bezel and said gemstone at a predetermined, discrete speed;

a gear assembly including a plurality of gears driven by said motor means and operably connected to said bezel, said gears having a predetermined, precise gear ratio for rotating said bezel at a discrete speed, wherein said gear assembly further includes a drive gear connected to said motor means, an intermediate gear engaging said drive gear, said intermediate gear having an upper surface with a sprocket extending therefrom and a bezel gear connected to said bezel and engaging said sprocket.

Claim 12. The jewelry item according to claim 11 wherein said discrete speed is between 2 and 4 revolutions per minute.

Claim 13. The jewelry item according to claim 11 wherein said motor means includes a quartz movement motor.

Claim 14. The jewelry item according to claim 13 wherein said motor means further comprises an integrated circuit for controlling speed and torque of said quartz movement motor.

Claim 15. The jewelry item according to claim 13 wherein said quartz movement motor includes a casing having an outer edge with an indentation thereon, said indentation substantially aligned with an opening on an outer wall of said housing, said indentation having at least one

electrical contact therein, said electrical contact electrically connected to said motor;

Claim 16. The jewelry item according to claim 15 further comprising a switch hingedly secured at a first end to said housing, said switch carrying a battery thereon, said switch having a free end which is pivotal towards and away from said housing to selectively position said battery against said contact.

Claim 17. The jewelry item according to claim 11 further comprising a lower spacer plate superimposed on said drive gear, said spacer plate having an aperture with said drive gear received therein.

Claim 18. The jewelry item according to claim 11 further comprising:
a neck projecting upwardly from said bezel gear, said neck having a peripheral lip;
said bezel receiving said neck, said bezel including a circumferential slot positioned beneath said lip;
a clip received within said slot to retain said bezel on said neck.

Claim 19. The jewelry item according to claim 17 wherein said lower spacer plate includes a depression thereon that receives said intermediate gear.

Claim 20. The jewelry item according claim 19 further comprising an upper spacer plate superimposed on said lower spacer plate with said intermediate gear positioned therebetween.

IX

Evidence Appendix

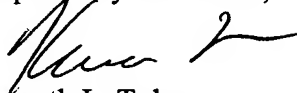
N/A.

X.

Related Proceedings Appendix

N/A.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner of Patents and Trademarks, P.O. Box 1450, Alexandria, Virginia 22313 on this 31st day of January, 2007.

Kenneth L Tolar (Name of person making deposit)

[Signature] (Signature)

1.31.07 (Date)